

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/437,276	11/10/99	PAULS	M 3548.04-1

IM22/1016
PHILLIPS MOORE LEMPIO AND FINLEY
SUITE 6
385 SHERMAN AVENUE
PALO ALTO CA 94306-1840

EXAMINER

SERGENT, R

ART UNIT	PAPER NUMBER
1711	13

DATE MAILED: 10/16/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/437,276	Applicant(s) Pauls et al.
	Examiner Rabon Sergeant	Art Unit 1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on Jun 26, 2001

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-29 is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-29 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are objected to by the Examiner.

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) All b) Some* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) <input type="checkbox"/> Notice of References Cited (PTO-892)	18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
16) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
17) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____	20) <input type="checkbox"/> Other: _____

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1. The amendments to the specification, filed March 5, 2001, have not been entered, because the cited locations for the text to be entered do not correspond to the text of the originally filed pages. The amendments must correspond to the originally filed pages. Pages of text filed March 5, 2001 have not been entered; therefore, amendments should not be directed to locations present in these unentered pages.
2. Claims 2-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants' claiming of the pressure filled can and prepolymer is confusing. It would seem that the can contains the prepolymer; the significance of specifying them separately is unclear. Within claims 17 and 28, applicants have referred to the prepolymer composition of claims 1 and 15; however, claims 1 and 15 are directed to a pressure filled can. Within line 2 of claim 16, "softening" has not been spelled correctly.
3. Claims 7, 9, 21, and 22 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants have failed to provide adequate support for the claimed bases for the weight percents. Within claims 7 and 9, the basis is the prepolymer composition. Within claims 21 and 22, the basis is the prepolymer component. The bases between the two sets of claims do not agree.

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4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CAR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pauls ('412) in view of Falkenstein et al. ('313) and Friedman ('827) and further in view of either Nichols et al. ('646) or Burkhart et al. ('270).

Pauls discloses a storage stable polyurethane prepolymer composition, having an NCO content of 5 to 25 percent by weight, which may be dispensed from a pressure can to yield a dimensionally stable foam. See abstract and columns 2-4.

6. Pauls is silent regarding the use of phosphorous containing compounds as softeners, castor oil-based polyols, and polybutadiene; however, the use of each of these components within polyurethane foam formulations was known at the time of invention. Falkenstein et al teach at

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column 3, lines 59-66 that the use of phosphorous containing compounds soften the foam and increase flame resistance. Friedman teaches the use of phosphorous containing polyols to provide flame resistance and further teaches at column 5, lines 62+ that castor oils may be used to prepare prepolymers. Burkhart et al disclose the use of liquid polybutadiene as a foam additive and a cell opening agent within polyurethane foams. See column 3, lines 62+ within Burkhart et al. Furthermore, Nichols et al. disclose at column 1, lines 33-35 the use of polybutadienes as cell opening agents for polyurethane foams. The polybutadienes of Nichols et al. are considered to encompass liquids, because patentees refer to them as bleeding out, giving the foam an oily feel, at column 1, lines 50 and 51.

7. Despite applicants' argument concerning the selection and combination of the respective components, the position is maintained that it would have been obvious to utilize known components for their known functions within polyurethane compositions. It has been held that it is prima facie obvious to utilize a compound for its known function (In re Linder, 173 USPQ 356; In re Dial et al., 140 USPQ 244); therefore, one of ordinary skill in the art would have been motivated to utilize the known polyurethane foam components with the teachings of the Pauls reference, so as to obtain a pressure can dispersible prepolymer capable of yielding a foam having improved flame resistance, dimensional stability, and softness. Applicants have failed to provide any showing of unexpected results attributable to the claimed composition.

8. Applicants' argument that Falkenstein et al. are concerned with a polyisocyanurate, rather than a polyurethane and that, as a result, their teachings should not be applied to a polyurethane

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composition is not agreed with, because polyisocyanurate and polyurethane foams are derived from the same reactant species, polyisocyanurates contain urethane linkages, and the skilled artisan recognizes that the two species of compositions are closely related.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CAR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CAR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (703) -308-2982.

Sergent/LR

October 9, 2001

Rabon Sergent
RABON SERGENT
PRIMARY EXAMINER